

UNITED STATES DISTRICT COURT  
FOR THE SOUTHERN DISTRICT OF NEW YORK

BNP PARIBAS

*Declaratory Judgment Plaintiff,*

v.

CONNEXUS CREDIT UNION

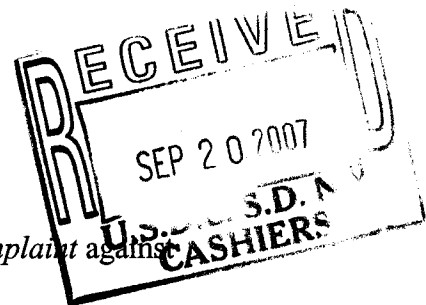
*Declaratory Judgment Defendant.*

**JUDGE McMAHON**  
**07 CIV 8217**  
Civil Action No. \_\_\_\_\_

**COMPLAINT**

Declaratory Judgment Plaintiff, BNP Paribas for its *Complaint* against

Declaratory Judgment Defendant, Connexus Credit Union, alleges upon knowledge as to its own acts and upon information and belief as to the acts of others as follows:



**Nature of Action and Subject Matter Jurisdiction**

1. This is an action for declaratory judgment under 28 U.S.C. §§ 2201 and 2202.
2. Subject matter jurisdiction over this action is conferred upon this Court by 28 U.S.C. §§1331, 1332, and 1338 in that, among other things, the matter to be litigated raises one or more federal questions, the dispute is between citizens of different states, and the amount in controversy exceeds the value of \$75,000.

### **Personal Jurisdiction and Venue**

3. This Court has jurisdiction over Defendant and venue is properly laid in this District under 28 U.S.C. § 1391(b) and (c) in that Defendant regularly transacts business in this District, which is also where Plaintiff resides.

### **Parties**

4. Plaintiff BNP Paribas (“BNP Paribas”) is a corporation organized and existing under the laws of France, and with a principal place of business at 16 Boulevard des Italiens, 75009 Paris, France. BNP Paribas’ principal place of business in the United States is at 787 Seventh Avenue, New York, New York 10019.
5. Defendant Connexus Credit Union (“CCU”) is a credit union chartered and existing under the laws of the State of Wisconsin with a principal place of business at 2600 Pine Ridge Boulevard, Wausau, Wisconsin 54402.

### **BNP Paribas’ CONNEXIS Service**

6. BNP Paribas is the one of the largest international banking networks in the world, with operations in more than 85 countries. BNP Paribas serves its diverse worldwide clientele through three core businesses: retail banking, asset management, and corporate and investment banking.
7. Through its retail banking business, BNP Paribas primarily provides consumers in countries around the world with a complete range of retail banking products and services, such as basic current accounts (*e.g.*, checking, savings), various loan programs, and estate management. In the United States, BNP Paribas offers retail

banking through its BancWest subsidiary, which operates more than 700 retail banks, primarily in the western United States and Hawaii.

8. The services BNP Paribas offers its corporate and institutional clients, however, are somewhat different. To meet the specialized needs for development and financial optimization faced by these clients, BNP Paribas seeks to leverage its in-depth expertise across a full range of global banking services. Thus, within its corporate and investment banking arm alone, BNP Paribas has dedicated roughly 1,100 employees to serve roughly 7,000 corporate and institutional clients, thus fostering the development of strong, personal relationships.
9. The clients that BNP Paribas serves through its corporate and investment banking business primarily include multi-national corporations with worldwide operations, companies with a strong regional presence in Europe, and large companies with a significant presence in their own domestic market. BNP Paribas also has strong relationships with many financial institutions, general and specialized banks (public or private), insurance companies, pension funds, mutual health insurers, fund managers, and supranational organizations. Through its retail banking business, BNP Paribas primarily serves local businesses, but it also has a number of small- to mid-sized businesses (or larger) that have a particular need for the type of global financial services BNP Paribas' largest clients require.
10. One of the services that BNP Paribas offers its corporate clients is "cash management," which encompasses a wide range of solutions for managing day-to-day cash flows and optimizing liquidity. For those clients that need sophisticated global financial services, or which have a significant international

presence, one of the components of that cash management service may include the company's "CONNEXIS" Global Transaction Management solution.

11. BNP Paribas' CONNEXIS service, however, is only available to corporate clients who are already part of the BNP Paribas global banking network. As such, a client must have an existing banking relationship with BNP Paribas before it may enroll in the CONNEXIS service. The CONNEXIS service is not offered to retail banking consumers, nor is it made available to local businesses unless they have a particular need for the complex global transactional solutions it provides.
12. Once provided access to the CONNEXIS service, clients can monitor and manage their global cash positions, initiate local or cross-border individual or mass payments (such as payroll), issue letters of credit, exchange specific electronic file formats, and execute large volume transactions, among other services.
13. Online access to the CONNEXIS service is tightly controlled and password protected, using dedicated BNP Paribas branded websites that have been tailored for clients in five distinct global regions. Thus, for example, corporate clients based in North America may access the CONNEXIS service through the website <http://canada-connexis.bnpparibas.com>, but they must enter their ID and password before they can access the CONNEXIS system. *See* Ex. A.
14. Information about BNP Paribas' CONNEXIS service is not generally available to retail banking consumers, nor does BNP Paribas publicly "advertise" the service in the traditional sense. Rather, BNP Paribas typically promotes its service to its existing corporate clients on a personal basis, and provides general information

about the service through certain BNP Paribas publications and websites, which are clearly branded as emanating from BNP Paribas. *See, e.g.*, Ex. B.

15. BNP Paribas has offered the CONNEXIS system to certain areas of the world since at least as early as 2001. In December 2003, the company extended the service to U.S.-based clients. Since then, approximately 100 corporate clients in the United States have enrolled in the CONNEXIS services.

### **The History of the Connexus Credit Union**

16. In or around December 1987, the Oregon Central Credit Union, based in Portland, Oregon, began using the name CONNEXUS for a computerized banking service that could be accessed by way of a telephone or a modem-equipped personal computer. Later, the credit union applied for, and was subsequently granted, U.S. Trademark Reg. No. 1537662 for the name CONNEXUS covering “computerized banking services operated by phone and personal computer.”
17. In mid-2003, the Oregon Central Credit Union assigned all of its rights in U.S. Reg. No. 1537662 and the CONNEXUS name to a Wisconsin credit union then known as the Wausau Insurance Employees Credit Union. Despite the transfer, however, a number of credit unions on the west coast (including the Oregon credit union) continued to use the original CONNEXUS-branded home banking service.
18. The Wisconsin credit union that purchased U.S. Reg. No. 1537662 subsequently changed its name to “Connexus Credit Union” and began using the mark in connection with the provision of retail credit union services, primarily in and around Wausau, Wisconsin. Around the same time, the credit union (under its

original name) applied for, and was subsequently granted, U.S. Trademark Reg. No. 3039935 for the name CONNEXUS covering “credit union services.”

19. The Connexus Credit Union claims that it has approximately 18,000 members across the United States, and that its CONNEXUS-branded debit, credit, and ATM cards are accepted (and used by members) nationwide. The credit union, however, does not permit corporate entities to be members, nor does it offer any banking services (such as commercial lending) to the business community.

#### **The Existence of an Actual Controversy**

20. An actual controversy exists between the parties relating to BNP Paribas’ use of “CONNEXIS” in connection with its global transaction management services.
21. Specifically, in late 2006, BNP Paribas approached the Connexus Credit Union with regard to a matter concerning U.S. Trademark Application No. 78611959, which BNP Paribas filed in April 2005 for the mark CONNEXIS for “Global financial transaction management services, namely offering cash management, issuing letters of credit, accounts receivable financing, accounts payable debiting services, for corporate clients through a secure, online transactional platform.”
22. Prior to BNP Paribas approaching CCU there had been no contact between the parties. Moreover, statements made by representatives for CCU at that time suggest that no one at the credit union (let alone any customers or potential customers) had heard of BNP Paribas’ prior use of the CONNEXIS name.

23. Discussions between the parties to resolve the matter concerning U.S. Trademark Application No. 78611959 continued through this month. On September 7<sup>th</sup>, however, CCU rejected BNP Paribas' latest proposal and had its outside counsel send a formal "cease and desist letter" to BNP Paribas' office in New York City in which the credit union demanded that BNP Paribas cease all use of the CONNEXIS name in the United States in connection with banking services.
24. Specifically, the credit union claimed that BNP Paribas' use of CONNEXIS in the manner described above "creates a likelihood of confusion" in the marketplace and that such use "constitutes an infringement of [the credit union's] trademark rights," including those represented by U.S. Reg. Nos. 1537662 and 3039935. *See* Ex. C. Further, the credit union asserted that such use "violates federal trademark law" and cited Section 32 of the Lanham Act [15 U.S.C. §1114] for support, which section provides a federal cause of action to remedy the infringement of a registered mark. *See id.*; *see also* 15 U.S.C. §1114. The credit union then closed its letter by threatening that if BNP Paribas failed to agree by September 15<sup>th</sup> to cease "all use of 'Connexis' in connection with ... banking services," the credit union "shall without further notice to you take such action as it deems advisable to assert its rights and to otherwise protect its interests." *See* Ex. C.
25. The deadline set by the credit union has now passed, and BNP Paribas is continuing to use the CONNEXIS mark (as is its legal right). In view of the above, though, BNP Paribas has a real and reasonable apprehension that its continuing actions will result in the credit union bringing a claim for liability, which could disrupt BNP Paribas' business operations. Thus, BNP Paribas has initiated this action for the purposes of seeking declaratory relief and resolution

concerning its right to use the CONNEXIS name in connection with the offering of global financial transaction management services in this country.

## **COUNT I**

### **Declaratory Judgment — Noninfringement**

26. BNP Paribas incorporates by reference its allegations in paragraphs 1-25 above.
27. BNP Paribas' use of "CONNEXIS" in connection with the provision of global financial transaction services to corporate clients through a secure, online transactional platform is not likely to cause confusion or mistake, or to deceive, as to the affiliation, connection, or association of BNP Paribas with CCU, or as to the origin, sponsorship, or approval by CCU of BNP Paribas' services.
28. BNP Paribas' use of "CONNEXIS" in connection with the provision of global financial transaction services to corporate clients through a secure, online transactional platform is not likely to cause confusion or mistake, or to deceive, as to the affiliation, connection, or association of CCU with BNP Paribas, or as to the origin, sponsorship, or approval by BNP Paribas of CCU's services.
29. Accordingly, BNP Paribas seeks a declaration that its use of "CONNEXIS" in connection with the provision of global financial transaction services to corporate clients through a secure, online transactional platform does not infringe upon any valid rights that CCU claims to have in the CONNEXUS name, including any rights represented by U.S. Trademark Reg. Nos. 1537662 and/or 3039935, or which may exist under the common law.



and that this Court award to BNP Paribas any such other and further relief as this Court may deem just and proper.

Respectfully submitted,

Dated: September 20, 2007

*Of Counsel:*

Edward T. Colbert

William M. Merone

KENYON & KENYON LLP

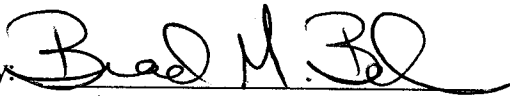
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By:



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*Counsel for BNP Paribas*

# EXHIBIT A

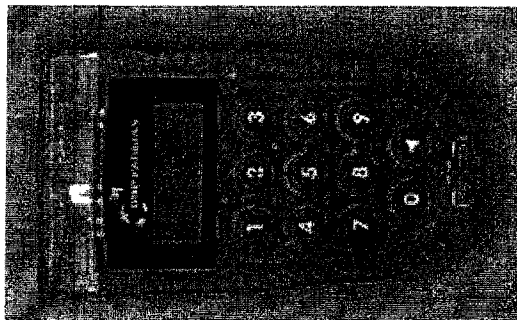


# Connexis

Please enter your  
connexis ID

Please enter your  
password

Login



This system is for authorized use only. Any unauthorized access of this system is strictly prohibited and is a violation of law. Activity may be monitored for security purposes.

[Click here to download Java Plugin](#)

IE6/IE7 Compliant

# EXHIBIT B

Search Careers Staff only

Products : Awards and Ranking : Websites : Research : Contact : News



Home > [Web Sites](#) > [Servicing your operational needs](#) > [Cash Management](#) > Connexis

## Related Products

Cash Management

## Contact

Emmanuel MELLIER

Contact Details

## Connexis

Connexis is BNP Paribas Global Transaction Management solution available for corporate clients located within our global network. You benefit from a complete visibility and control over your accounts worldwide.

Connexis gives you access to both BNP Paribas accounts and to third-party banking information.

Account reporting and transaction initiation are executed in real time and in complete security thanks to state-of-the-art encryption technology and sophisticated validation processes. Connexis is designed to handle large volumes of data, and our custom-tailored solutions are fully integrated with your ERP system.

You can access the Connexis range of services from a single log-in.

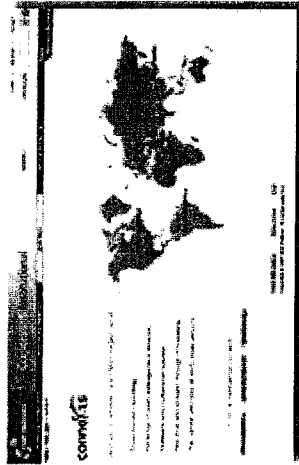
[Connexis demo - English](#)  
[Connexis demo - French](#)

## Major features

Connexis reporting: check your account position any time  
Connexis cash: make transfers and payments online  
Connexis FIT: exchange specific format files with your Bank

## Specificities

Available versions : French - English - Spanish  
Access : secured  
Geographical scope : ore, Taiwan, Thailand, Vietnam, Abu Dhabi, Bahrain, Dubai, Qatar  
Transactional services : yes



Go directly to: Connexis

Connexis brochure - English

**Connexis reporting**

Monitor your global cash position in real time whether your accounts are held in BNP Paribas network or in any third party bank. Connexis offers you the benefits of **multibranch and multibank solution** with access to all types of accounts. Access to these features:

- available balance
- provisional balance
- value date balance
- details of daily transaction (intradays operations)
- review of outstanding transactions
- account consolidation

Connexis reporting brochure - English  
Connexis reporting brochure - French

**Connexis cash**

Initiate your operations in **total security**: the architecture of Connexis ensures transaction integrity, confidentiality and authentication. Access to these features:

- fund transfer between company's accounts with automatic limit checking
- third parties payments (local and crossborder)
- individual and mass payments (payroll)
- cheque printing
- bank drafts and cashier orders issuing
- interface with treasury tools (uploading, downloading)

Connexis cash brochure - English  
Connexis cash brochure - French

**Connexis FIT**

**Exchange specific formats files** with BNP Paribas for the execution of large volume transactions :

- FIT supports the following formats :

Incoming : SWIFT MT940 after cash centralization  
Outgoing : SWIFT MT101

- Other formats - SAP IDoc, CFONB120, CFONB160, CFNOB320, CSB58(France), CSB43, CSB34 (Spain), STD18 (Ireland), PS(Portugal), DTA (Italie), CLIEOP03, BTL91(Netherlands) - will be progressively implemented.

Connexis FIT brochure - English  
Connexis FIT brochure - French

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# **EXHIBIT C**





EATON  
PROHASKA  
OVERBEY LLP

**CERTIFIED MAIL RETURN RECEIPT REQUESTED**

September 7, 2007

Mr. Ted Lull  
BNP Paribas  
787 Seventh Avenue  
New York, NY 10019

**Re: Cease and Desist Use of "Connexis"**

Dear Mr. Lull:

We represent Connexus Credit Union. Our client has learned that BNP Paribas has been using the name "Connexis" in connection with its banking services. Your use of a very similar name on a similar type of services offered by our client creates a likelihood of confusion in the marketplace and constitutes infringement of our client's trademark rights.

Our client owns the federally registered trademark CONNEXUS, U.S. Registration No. 1537662 (under IC 36, 100), for use in connection with computerized banking services operated by phone and personal computer. Our client also owns the federally registered trademark CONNEXUS, U. S. Registration No. 3039935 (under IC 36, 102) for use in connection with credit union services. Our client and our client's predecessor have used the mark CONNEXUS continuously since 1987, and the CONNEXUS registration has achieved incontestable status under 15 U.S.C. § 1065.

Our client's federal registrations grant it the exclusive nation-wide right to use the CONNEXUS mark in connection with services related to those recited in its registration. Any other parties' use of that mark, or any confusingly similar mark, infringes our client's trademark rights and violates federal trademark law. See 15 U.S.C. § 1114. Because BNP Paribas is using a very similar name on services similar to those of our client, confusion in the marketplace is inevitable. Accordingly, we must request that you cease and desist further use of the name "Connexis" or any other confusingly similar variation of our client's mark CONNEXUS.

We expect to receive your assurances by September 15, 2007, that you will discontinue all use of "Connexis" in connection with your banking services. If we receive your prompt assurances, we can accommodate an appropriate schedule for renaming your services and replacing your identifying and promotional materials. If you fail to so advise us by September 15, 2007, our

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Fax: 715.843.6775  
www.wausaulaw.com

Mr. Ted Lull  
September 7, 2007  
Page 2

client shall without further notice to you take such action as it deems advisable to assert its rights and to otherwise protect its interests.

Thank you in advance for your anticipated cooperation.

Sincerely,

**EATON, PROHASKA, OVERBEY & WELLES, LLP**

A handwritten signature in black ink, appearing to read "DB Welles", is written over a horizontal line.

David B. Welles

DBW:mjl

C: J. David Christensen  
William M. Merone, Esq.